

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN M. BULL

Appeal 2007-0472
Application 09/931,817
Technology Center 3700

Decided: March 13, 2007

Before HUBERT C. LORIN, ANITA PELLMAN GROSS, and ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The appeal is from a decision of the Examiner rejecting claims 25-28 over the prior art¹. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6 (b) (2002).

We AFFIRM.

¹ Claims 1-24 and 29-39 are subject to restriction and have been withdrawn from consideration.

Appellant, in the Brief², argues the claims as a group. Pursuant to the rules, the Board selects representative claim 25 to decide the appeal.

37 CFR § 41.37(c)(1)(vii) (2005).

Claim 25 reads as follows:

25. A method of providing a game that creates awareness of at least one sponsor, the method comprising:

defining a plurality of game spaces, each game space including an advertising object and a clue involving the advertising object, wherein solving the clue includes interacting with the advertising object, thereby creating awareness of a sponsor of the advertising object; and

after solving the clue, directing a player to proceed from one game space to a next game space including a next advertising object.

ISSUES

The issue on appeal is whether Appellant has shown that the Examiner erred in concluding that a prima facie case of anticipation and/or obviousness is made by Sporgis' disclosure of a treasure hunt type game run from a website having advertisements played on a web-enabled wireless communication device receiving solvable clues.

² Our decision will make reference to Appellant's Appeal Brief ("Br.," filed 1 September 2006), the Examiner's Answer ("Answer," mailed 25 September 2006) and to the Reply Brief ("Reply Br.," filed 10 October 2006).

FINDINGS OF FACT

The following findings of fact (FF) are believed to be supported by at least a preponderance of the evidence. To the extent any finding is a conclusion of law, it may be treated as such.

1. The invention claimed is drawn to a method of playing a game involving game spaces, advertising objects, and clues. Solving a clue includes interacting with the advertising object and once solved directs the player to proceed to the next game space and corresponding advertising object.
2. The Examiner finally rejected claims 25-28 as being unpatentable under 35 U.S.C. § 102(e) or 103(a) over Sporgis (Answer 3).
3. U.S. Patent 6,320,495 (“Sporgis”) issued on 20 November 2001 on an application filed on 24 March 2000 and therefore qualifies as prior art under 35 U.S.C. § 102(e).³
4. The Examiner has made a limitation-by-limitation analysis of the claims. (Answer 4-5).
5. The Examiner finds that “either Sporgis inherently has at least one advertising object in each game space (i.e., as a clue), or it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sporgis to have at least one advertising object in each game space in order to carry out the suggestion that commercial sponsors may support the game in exchange for advertising rights.” (Answer 4).
6. Appellant makes one rebuttal argument to the Examiner’s prima facie case:

³ Appellant does not challenge Sporgis’ qualifications as prior art.

“Appellant respectfully submits that Sporgis fails to disclose or suggest a game that creates awareness of a sponsor by interacting with an advertising object of the sponsor to solve a clue.”

(Br. 5-6).

7. Appellant finds, as we do, that Sporgis (col. 5, ll. 45-47) describes giving players clues which (when solved) direct them to locate various items. (Br. 5).

8. Sporgis (col. 2, ll. 28-35) also indicates that the

use of a web enabled wireless communications device allows the internet and world wide web to be used as the medium to transmit clues to players and receive their positions. It also allows players to utilize the resources of the web to solve clues The web is also ideal for providing advertising space to game sponsors and others.

9. Appellant finds, as we do, that Sporgis (col. 3, ll. 21-23) discloses that commercial sponsors can support a game in exchange for affiliation with the game and advertising rights. (Br. 6).

10. Appellant finds, as we do, that Sporgis (col. 3, ll. 52-55) discloses that advertisements can be placed on the website. (Br. 6).

11. The Specification does not provide a definition for the phrase “advertising object” in the claims inconsistent with the plain meaning of the words. When plainly read, “advertising object” means a thing that communicates an advertisement and therefore has a scope encompassing websites containing advertisements. Moreover, the Specification (inter alia, paragraphs 0024, 0029, 0049, and 0050) describes embodiments where players solve clues by accessing websites on web enabled communication devices and the websites providing clues include advertisements.

PRINCIPLES OF LAW

1. “The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990). The term “*prima facie* case” refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.” *In re Oetiker*, 977 F.2d 1443, 1444, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).
2. Claims are given the broadest reasonable construction consistent with the specification. *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997).

ANALYSIS

The Examiner has made a limitation-by-limitation analysis of the claims. Based on the analysis, the Examiner finds that Sporgis anticipates or renders obvious the claimed subject matter. FF 5. The burden now shifts to Appellant to come forward with evidence or argument showing error in Examiner’s determination.

Appellant contends that Sporgis fails to disclose or suggest a game that creates awareness of a sponsor by interacting with an advertising object of the sponsor to solve a clue. FF 6. The evidence does not support Appellant’s contention.

Sporgis describes a treasure hunt type game whereby clues are communicated to the players of the game through a website displayed on web enabled communication devices. FF 8. Sporgis also discloses that the website may include advertisements. FF 8-10. Accordingly, Sporgis

describes a treasure hunt type game whereby clues are communicated to the players of the game through a website having advertisements. In playing such a game, solving a clue necessarily involves interacting with the advertising website.

Turning to the claim, it describes a game featuring “an advertising object and a clue involving the advertising object, wherein solving the clue includes interacting with the advertising object.” When given its broadest reasonable construction consistent with the Specification (FF 11), the phrase “an advertising object” encompasses a website with advertisements. Therefore, in calling for “an advertising object and a clue involving the advertising object, wherein solving the clue includes interacting with the advertising object,” the claim encompasses a game featuring an advertising website and a clue involving the advertising website wherein solving the clue involves interacting with the advertising website.

Because the claim encompasses a game featuring an advertising website and a clue involving the advertising website wherein solving the clue involves interacting with the advertising website, it reads on the Sporgis method, i.e., a treasure hunt type game whereby clues are communicated to the players of the game through a website having advertisements wherein solving a clue necessarily involves interacting with the advertising website.

As to that part of the contention which argues that Sporgis fails to disclose or suggest a game that creates awareness of a sponsor, since we have found that Sporgis discloses and/or suggests the step in the claims that creates the awareness of a sponsor, i.e., the step of interacting with an advertising object, we furthermore find Sporgis discloses and/or suggests the result of that step, i.e., creating awareness of a sponsor.

CONCLUSION OF LAW

On the record before us, the Examiner's evidence and rationale is sufficient to make out a prima facie cases of anticipation and obviousness under 35 U.S.C. §§ 102(e) and 103. On the record before us and for the foregoing reasons, Appellant has not shown that the Examiner erred in concluding that prima facie cases of anticipation and obviousness are made by Sporgis' disclosure of a treasure hunt type game run from a website having advertisements played on a web-enabled wireless communication device receiving solvable clues.

Comment: The Specification is replete with references to goods and services by their respective trade names or trademarks. The Examiner should keep in mind that when a specification refers to goods and services by their respective trade names or trademarks, a generic description must be inserted in place of, or in addition to, a trade name or trademark. *The Manual of Patent Examining Procedure (MPEP)* § 608.01(v) (2006) provides guidelines by which the Specification may be amended to provide the necessary generic description while avoiding questions of new matter. *See also In re Metcalfe*, 410 F.2d 1378, 1382, 161 USPQ 789, 792 (CCPA 1969).

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DECISION

The Examiner's rejection of claims 25-28 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 CFR § 1.136(a)(1)(iv) (2006).

AFFIRMED

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